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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,938	09/28/2000	Jeffery A. Livesay	4969.02	7604
7590	11/26/2003		EXAMINER	
Brad J Hattenbach Esq DORSEY & WHITNEY LLP 370 17TH STREET SUITE 4700 DENVER, CO 80202-5647			GORT, ELAINE L	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 11/26/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/672,938	LIVESAY, JEFFERY A.
	<b>Examiner</b>	<b>Art Unit</b>
	Elaine Gort	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 October 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-172 is/are pending in the application.
  - 4a) Of the above claim(s) 1-109 and 122-163 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 110-121 and 164-172 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3,4</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. Computer readable medium which matches buyers and sellers to communicate requests, bids and contracts for goods/services; and

B. Computer readable medium for obtaining profile information on a seller.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Brad Hattenbach (20686) on November 13, 2003 a provisional election was made without traverse to prosecute the invention of A. above including claims 110-121 and 164-172. Affirmation of this election must be made by applicant in replying to this Office action. Claims 122-128 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 1-109 and 122-163 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7 and in the above species restriction phone call to Brad Hattenbach.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 110-121 and 164-172 are rejected because they lack patentable utility.

Claims 110-121 and 164-172 only claim the manipulation of data but perform no concrete, useful or tangible result.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 110-121 and 164-172 are rejected under 35 U.S.C. 102(e) as being anticipated by Primavera and PurchasePro.com (Business Wire, 9/21/99, p. 203).

Primavera and PurchasePro.com disclose the claimed computer readable medium containing instructions for facilitating the matching of buyers and sellers for goods/services specified for a project. Primavera and PurchasePro.com disclose a

website with computer readable medium capable of defining/identifying a project with parameters (such as performance specifications); converting the parameters into a request for goods/services needed to complete the project (specifications/RFQs/RFPs are presented to sellers which include the buyers performance specifications); where the request is utilized by a buyer to communicate the parameters for the project to at least one seller providing the goods/services needed for the project (such as when the system connects buyers and sellers); the request is communicated to a seller; prepares a response by a seller based on the request for goods/services (such as preparing a contractor's bid for conveyance to the buyer); communicates a response to the buyer from a seller as an offer to provide the buyer with the goods/services requested (such as when system conveys bids to buyers); where the request identifies at least one goods/services specified for a project defined in terms of at least one parameter (such as buyer's request includes project specifications); and where acceptance of the response by the buyer, a contract for the goods/services specified in the response is formed between the buyer and the seller.

7. Claims 110-121 and 164-172 are rejected under 35 U.S.C. 102(e) as being anticipated by Huberman (US Patent 5,826,244).

Huberman discloses the claimed computer readable medium containing instructions for facilitating the matching of buyers and sellers for goods/services specified for a project. Huberman discloses a website with computer readable medium capable of defining/identifying a project with parameters (for example specifications relating to the printing of an annual report); converting the parameters into a request for

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goods/services needed to complete the project (specifications are presented to sellers which include the buyers performance specifications); where the request is utilized by a buyer to communicate the parameters for the project to at least one seller providing the goods/services needed for the project (such as when the system connects buyers and sellers); the request is communicated to a seller; prepares a response by a seller based on the request for goods/services (such as when bids are prepared by sellers); communicates a response to the buyer from a seller as an offer to provide the buyer with the goods/services requested (such as when system conveys bid information to buyers); where the request identifies at least one goods/services specified for a project defined in terms of at least one parameter (such as buyer's request includes project specifications); and whereupon acceptance of the response by the buyer, a contract for the goods/services specified in the response is formed between the buyer and the seller (such as when the customer accepts the transaction).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone

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number for the organization where this application or processing is assigned is  
(703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG *EJ*  
November 13, 2003

 11/17/03

ROBERT P. OLSZEWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600